REMARKS

The pending Office Action addresses claims 61-94, allowing claims 72-74 and 84-89, rejecting claims 61-65, 67-71, and 75-83, and objecting to claim 66. Claims 90-94 are withdrawn from consideration.

Information Disclosure Statement

Per the Examiner's request, Applicant re-submits herewith copies of EP 87302940.9 and EP 86117360.7 cited in the IDS filed on November 17, 2003. Applicant encloses a new PTO/SB/08 and requests that the Examiner consider these references and initial the attached form indicating that they have been considered.

Amendments to the Specification

Applicant amends the Abstract and Title to overcome the Examiner's objection that they fail to describe the method that is presently claimed. No new matter is added.

Amendments to the Claims

Applicant amends independent claim 61 to specify that inserting the insertion element into the stabilizing element causes the stabilizing element to deformably expand and obtain a pressure fit within the bone opening. Support for this amendment can be found throughout the specification, for example, at page 3, lines 21-24. Applicant amends independent claim 75 to specify that the insertion element is held in the stabilizing element by a compression fit. Support for this amendment can be found throughout the specification, for example, at page 8, lines 30-31. Claims 68 and 71 have been amended to recite "includes" in place of "comprises." Applicant amends claims 69, 72, 73, and 77 to correct a typographical error. Claim 70 is canceled. Applicant cancels claims 90-94, as these claims are withdrawn from consideration. Applicant reserves the right to pursue these claims in a divisional application. Applicant also adds new independent claim 95, which includes the limitations of claims 61, 63, and 66. No new matter is added.

Rejection Pursuant to 35 U.S.C. §102

The Examiner rejects claims 61, 62, 67, and 70 pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,151,104 of Kenna ("Kenna"). Applicant respectfully disagrees.

Independent claim 61, as amended, recites a method for anchoring soft tissue within bone including the steps of drilling an opening into bone, inserting a stabilizing element into the bone opening, threading soft tissue through an aperture in an insertion element, and inserting the insertion element into the stabilizing element causing the stabilizing element to deformably expand and obtain a pressure fit within the bone opening. Kenna fails to teach or suggest a method for anchoring soft tissue in bone whereby insertion of an insertion element causes a stabilizing element to deformably expand and obtain a pressure fit within the bone opening. Kenna discloses a method of connecting two parts of a joint using a threaded first portion (30) and a second portion (32) having a nose (34). In use, the threaded first portion (30) is screwed into a pre-drilled bone hole, and the nose (34) of the second portion (32) is inserted into the first portion (30). (Kenna column 3, lines 45-61; column 5, lines 7-20). The second portion (32) is secured in the first portion (30) by locking pins (54) that are adapted to snap into and remain self-locked within a groove (33) formed in the first portion (30). (Kenna column 4, lines 27-47). Kenna's first portion (30) is not expandable, and the second portion (32) does not obtain any type of pressure fit within the first portion (30). Kenna therefore fails to teach or suggest causing a stabilizing element to deformably expand and obtain a pressure fit within a bone opening, as required by independent claim 61.

Accordingly, claim 61, as well as claims 62-69 and 71 which depend directly or indirectly therefrom, distinguish over Kenna and represent allowable subject matter.

Rejection Pursuant to 35 U.S.C. §103

The Examiner rejects claims 69, 75-80, and 82 pursuant to 35 U.S.C. §103(a) as being obvious over Kenna in view of U.S. Patent 5,707,395 of Li ("Li"). The Examiner argues that Kenna discloses the claimed invention, except for the step of looping the graft through the aperture. The Examiner relies on Li to teach looping, arguing that it would have been obvious to modify the device of Kenna in view of Li to arrive at the claimed invention. Applicant respectfully disagrees.

Claim 69 depends from independent claim 61 which, as described above, recites a method for anchoring soft tissue within bone including the steps of drilling an opening into bone, inserting a stabilizing element into the bone opening, threading soft tissue through an aperture in an insertion element, and inserting the insertion element into the stabilizing element causing the stabilizing element to deformably expand and obtain a pressure fit within the bone opening. The insertion element includes a stem having an aperture-containing stem head. Kenna and Li both fail to teach or suggest inserting an insertion element into a stabilizing element to cause the stabilizing element to deformably expand and obtain a pressure fit within the bone opening. As explained above, Kenna discloses a method of

connecting two parts of a joint using a threaded first portion (30) and a second portion (32) whereby the second portion (32) is secured in the first portion (30) by locking pins (54) that are adapted to snap into and remain self-locked within a groove (33) formed in the first portion (30). Kenna's first portion (30) is not expandable, and the second portion (32) does not obtain any type of pressure fit within the first portion (30). Li does not remedy the deficiencies of Kenna because Li also fails to disclose inserting an insertion element into a stabilizing element thereby causing the stabilizing element to deformably expand and obtain a pressure fit within the bone opening. Li teaches a method for ligament repair whereby an anchor member (20) having a longitudinally extending channel (28) and an aperture (24) for looping ligament or ligament replacement *receives* an expanding member (32). The anchor member (20) of Li is comparable to the insertion member of the claimed invention in that both Li and the claimed invention loop ligament through an aperture in this component. In other words, the anchor member (20) and insertion element are both used to anchor the ligament. In Li, the anchor member (20) or insertion element slides *over* the expanding member (32) or stabilizing element. (Li column 6, lines 43-51). In contrast, claim 61 requires the insertion element to be inserted into the stabilizing element. Accordingly, independent claim 61, as well as claims 62-69 and 71 which depend directly or indirectly therefrom, distinguish over Kenna and Li, taken alone or combined, and therefore represent allowable subject matter.

Independent claim 75, as amended, recites a method for replacing a torn ligament including the steps of obtaining a tendon graft, drilling a hole into bone, looping the tendon graft through an aperture in an insertion element, inserting a stabilizing element into the bone hole, and inserting the insertion element into the stabilizing element. The insertion element includes a stem with an aperture-containing stem head and is held in the stabilizing element by a compression fit. Kenna fails to teach or suggest holding an insertion element in a stabilizing element by a compression fit. Kenna, as discussed above, discloses a method of connecting two parts of a joint using a threaded first portion (30) and a second portion (32) whereby the second portion (32) is secured in the first portion (30) by locking pins (54) that are adapted to snap into and remain self-locked within a groove (33) formed in the first portion (30). Kenna teaches a mechanical locking mechanism and fails to disclose holding an insertion element in a stabilizing element by compression fit. (Kenna column 4, lines 27-47). Li does not to remedy the deficiencies of Kenna because Li fails to disclose inserting an insertion element into a stabilizing element and holding the insertion element in the stabilizing element by a compression fit. Li teaches a method for ligament repair whereby an anchor member (20) having a longitudinally extending channel (28) and an aperture (24) provided at the distal end of the member (20) for looping ligament or ligament replacement slides *over* an expanding member (32). As explained above, the anchor member (20) of Li is comparable to the

insertion element of the claimed invention, and Li teaches sliding the anchor member (20) or insertion element *over* the expanding member (32) or stabilizing element. Thus, Li fails to disclose inserting an insertion element into a stabilizing element, as required by claim 75. Accordingly, independent claim 75, as well as claims 76-83 which depend directly or indirectly therefrom, distinguish over Kenna and Li, taken alone or combined, and therefore represent allowable subject matter.

Allowable Subject Matter

The Examiner has allowed claims 72-74 and 84-89 over the prior art. Claim 66 has been objected to as being dependent upon a rejected base claim. The Examiner has noted that claim 66 would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. New independent claim 95 has been added and includes the limitations of claims 61, 63, and 66. Applicant believes new independent claim 95 is in condition for allowance.

Conclusion

In view of the above amendments and remarks, Applicant submits that all claims are in condition for allowance, and allowance thereof is respectfully requested. Applicant encourages the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: January 20, 2006

Lisa Adams, Reg. No. 44,238
Attorney for Applicant

NUTTER, McCLENNEN & FISH, LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02110
Tel: (617) 439-2550
Fax: (617) 310-9550

1491067.1